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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/967,070

Applicant(s)

POND, RUSSELL

Examiner

EMEM STEPHEN

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 09/03/2008 have been fully considered but they are not persuasive.

The Applicant's argued limitation clearly states "the SVMS-MSC being configured to determine whether the intended recipient is capable of receiving the SVMS message prior to transmission of the SVMS message." However, the Applicant argues that Soh checks a database that resides at the SMC (not the mobile station). Firstly, the Applicant does not state communication with the mobile station to determine receiving capability on the claim; if this is what the Applicant means then the Applicant may amend the claims to reflect this, assuming no new matter is introduced.

Secondly, the Applicant's disclosure discloses "the SVMS-MSC 270 first determines whether MS 202 has SVMS capability. **It may, for example, have such information already stored in an SVMS-register (not shown) of its own, or it may query HLR 240 for the information.** In accordance with a preferred embodiment of the present invention, HLR 240 maintains information relating to the capabilities of mobile stations registered there. **The HLR 240 information about a given mobile station is specific enough to determine whether the subscriber utilizes a voice-mail feature, or whether the mobile station has SVMS capability** (see par. 37). Which is disclosed by Soh; Soh discloses "method for generating multimedia events by using the SMS in a mobile communication system is provided that includes selecting a multimedia event subjected to be transmitted to a receiving mobile station by an originating mobile

station, transmitting an index corresponding to the selected event and an identification number of the receiving mobile station from the originating mobile station to a short message service center (SMC), **checking** whether the receiving mobile station already contains data corresponding to the selected event **by the short message service center (SMC) using a database accessed by the SMC**, and transmitting only the index corresponding to the selected event from the short message service center (SMC) to the receiving mobile station **if the receiving mobile station already contains the data.**" "Multimedia Teleservice" indicates that the contents of the SMS are related to the multimedia events or their corresponding data, and **the multimedia events or the corresponding data are preferably retained in the SMC. The SMC preferably assigns a serial number to every multimedia event and shares the serial number information with all other mobile stations.** In addition, **each mobile station preferably stores a given amount of the multimedia data in cache-memory or the like, and a database regarding to the index of the stored multimedia data is retained in the SMC.** Therefore, Soh discloses "the SVMS-MSC being configured to determine whether the intended recipient is capable of receiving the SVMS message prior to transmission of the SVMS message."

Therefore, the rejections are maintained and repeated below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 8-11 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soh et al. (US-6,895,251 hereinafter, Soh) in view of Eteminan (US-6,801,524).

Regarding claim 1, Soh teaches a system (Col. 1 lines 38-51) comprising:

a first communication station (Fig. 1 [1]), comprising:

a packet-data generator for converting a short voice message service (SVMS) message into a packet-data format for transmission (Col. 4 lines 51-59) through a radio communication network, the SVMS message being defined as a message including packetized voice data configured to be deliverable to a recipient as a result of a single transmission from the first communication station; (Col. 1 lines 28-32) and

a storage device for electronically storing the SVMS message until it can be transmitted to a short voice message service mobile switching center (SVMS-MSC); (Col. 4 lines 1-4) and

the SVMS-MSC (Fig. 1 [4]) for receiving the packetized SVMS message (Fig. 4 [S₂] and Col. 4 lines 4-10 & 32-50) and storing it until it can be transmitted to the intended recipient (Col. 3 lines 55-65 and Col. 4 lines 7-17), the SVMS-MSC being configured to determine whether the intended recipient is capable of receiving the SVMS message prior to transmission of the SVMS message. (obvious because the SMC is sharing the multimedia event index information with the mobile stations [Col. 3 line 59-65] and prior to transmitting the multimedia event, checking whether the multimedia event is already located on the mobile station. [Col. 2 lines 54-60] Further

reasoning for obviousness is the objective of the invention is to conserve bandwidth by not transmitting the multimedia event repeatedly from the originating mobile station, but instead transmitting it once to the SMC where it is stored indexed, and from that point on, referred to by the index number where it can be downloaded on an "as needed" basis [Col. 2 line 61 through Col. 3 line 6)

Soh differs from the claimed invention by not explicitly reciting one SVMS message can be delivered to a plurality of recipients as a result of a single transmission from the originating communication station.

In an analogous art, Eteminan teaches a method and system for transmitting short-message or packet-switched service containing voice frames (Col. 8 lines 9-16 & 46-49 and Fig. 1 [20] *i.e.* a SVMS message) that includes the ability to transmit a single SVMS message to a plurality of recipients as a result of a single transmission from the first communication station (Fig. 1, Col. 9 lines 25-50, specifically 45-50 and Col. 10 lines 15-44, specifically lines 15-23), determining the routing for the SVMS messages (Col. 12 lines 35-41) and decoding the received packs for reproducing the voice signals. (Col. 13 lines 36-38) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the SVMS system of Soh after modifying it to incorporate the ability to transmit a single message to multiple recipients with only one transmission from the originating device of Eteminan.

One of ordinary skill in the art would have been motivated to do this since it saves bandwidth by freeing system resources at the base station by not having to

reserve limited system resources for receiving the same message multiple times, differing only by the recipients address. (Eteminan Col. 10, lines 15-23)

Regarding claim 2, Soh in view of Eteminan teaches a microphone (Eteminan Fig. 8 [72]) in the first communication station for receiving an audio input, converting it into electronic signals (Eteminan Fig. 8 [82]) and providing the electronic signals to the packet-data generator. (Eteminan Fig. 8 [96, 102, 104, 22 & 50])

Regarding claim 3, Soh in view of Eteminan teaches a text to speech (TTS) converter in communication with the first communication station for converting a text file into digital audio form and providing the digital audio signal to the packet-data generator. (Eteminan Col. 10 lines 45-53)

Regarding claim 4, Soh in view of Eteminan teaches the intended recipient is a mobile telephone (Soh Col. 4 lines 7-10 and Eteminan Col. 8 lines 20-22) and said system further comprises a home location register (HLR) for storing information regarding the mobile telephone. (Soh Col. 1 lines 38-51 & Eteminan Col. 8 lines 33-35)

Regarding claim 5, Soh in view of Eteminan teaches the SVMS-MSC queries the HLR to determine if the mobile telephone is SVMS capable. (Soh Col. 1 lines 50-51)

Regarding claim 8, Soh in view of Eteminan teaches the SVMS-MSC queries the HLR to determine the location of the mobile telephone. (Soh Col. 1 lines 46-51)

Regarding claim 9, Soh in view of Eteminan teaches the first communication station is connectable to the Internet such that the SVMS message may be transmitted to the SVMS-MSC through the Internet. (Eteminan Col. 12 lines 35-41 and Col. 14 lines 19-30)

Regarding claim 10, the limitations of claim 10 are rejected as being the same reason set forth above in claim 1.

Regarding claim 11, Soh in view of Eteminan teaches verifying delivery of the SVMS message to the target station. (Soh Col. 4 lines 17-24)

Regarding claim 19, the limitations of claim 19 are rejected as being the same reason set forth above in claim 1.

Regarding claim 20, the limitations of claim 20 are rejected as being the same reason set forth above in claim 1.

Regarding claim 21, the limitations of claim 21 are rejected as being the same reason set forth above in claim 1.

4. Claims 6, 7, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soh in view of Eteminan as applied to claim 5 above, and further in view of Martinez et al. (US-2002/0118800 hereinafter, Martinez).

Regarding claims 6 & 7, Soh in view of Eteminan teaches the limitations of claim 5 above, but differs from the claimed invention by not explicitly reciting that upon receiving a response from the HLR indicated that the mobile telephone is not SVMS capable, delivering the SVMS message by an alternative delivery method.

In an analogous art, Martinez teaches a telecommunications system that includes the ability to deliver stored test messages via alternative methods (Page 6 [0097]) including by a voice mail system. (Fig. 8B [86 & 96]) Although Martinez does not explicitly recite SVMS messages, Martinez does teach the ability to turn a standard text message into a voice message through Naturally Speaking software (Page 6

[0097]) to be forwarded to the external voice mail system. Therefore, sending a SVMS message to a voice mail system is obvious to one of ordinary skill since Martinez has already taught the process of converting a text message to a voice message and then forwarding the voice message to a voice mail system.

One of ordinary skill would recognize that if the SMS contains a voice message already, it is possible to then forward that message directly to the voice mail system without the additional processing for text-to-speech conversion. One of ordinary skill in the art would have been motivated to do this since it gives the end user many options for receiving messages.

Regarding claim 15, Soh in view of Eteminan and Martinez teaches directing transmission of the SVMS message comprises transmitting the SVMS message to a voice-mail server for storage. (Soh Col. 4 lines 1-4 and Martinez Page 6 [0097])

Regarding claim 16, Soh in view of Eteminan and Martinez teaches sending to the target station a notification that the SVMS message was transmitted to a voice-mail server. (Martinez Page 3 [0066])

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Soh in view of Eteminan as applied to claim 11 above, and further in view of Smith et al. (US-6,891,811 hereinafter, Smith).

Regarding claim 12, Soh in view of Eteminan teaches the limitations of claim 11 above, but differs from the claimed invention by not explicitly reciting sending a delivery confirmation notice to the originating station, upon verifying delivery.

In an analogous art, Smith teaches method and system for SMS transmission (Abstract) that includes sending a delivery confirmation notice to the originating station, upon verifying delivery. (Col. 3 lines 59-65) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the invention of Soh in view of Eteminan after modifying it to incorporate the delivery confirmation of Smith. One of ordinary skill in the art would have been motivated to do this since in order to confirm the reception of a message to the originating user.

6. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soh in view of Eteminan as applied to claim 10 above, and further in view of Kahan (US-2002/0024536 hereinafter, Kahan).

Regarding claims 17 and 18, Soh in view of Eteminan teaches the limitations of claim 10 above, but differs from the claimed invention by not explicitly reciting the SVMS message is received from an SVMS portal, wherein the portal is a World Wide Web site accessible by subscribers to direct that an SVMS message be generated upon the occurrence of a certain event.

In an analogous art, Kahan teaches a method and apparatus for personalized information to be sent to a mobile terminal subscriber (Abstract) that includes the SMS message is received from an SMS portal (Page 9 [0114]), wherein the portal is a World Wide Web site accessible by subscribers to direct that an SMS message be generated upon the occurrence of a certain event. (Page 9 [0103-0104], Fig. 9 and Pages 4-5 [0065-0066]). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the invention of Soh in view of Eteminan after

modifying it to incorporate the SMS portal of Kahan. One of ordinary skill in the art would have been motivated to do this since it enables automated reminders. (Page 5 [0059]) Although Kahan does not explicitly recite SVMS messages, Kahan does teach the ability to turn a standard text message into a voice message through text-to-speech conversion software. (Page 6 [0075])

Therefore, it would have been obvious to one of ordinary skill in the art to eliminate the text-to-speech conversion of Kahan and to transmit SVMS messages like that as taught by Soh (Col. 1 lines 38-51) and Eteminan. (Col. 8 lines 9-16 & 46-49 and Fig. 1 [20] *i.e.* a SVMS message).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMEM STEPHEN whose telephone number is 571 272 8129. The examiner can normally be reached on 8-5 Mon-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571 272 7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ES
12/11/2008

/Charles N. Appiah/
Supervisory Patent Examiner, Art Unit 2617